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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/609,147	06/30/2000	Jay S. Walker	99-110	2957

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WALKER DIGITAL  
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STAMFORD, CT 06905

EXAMINER

CARLSON, JEFFREY D

ART UNIT	PAPER NUMBER
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3622

DATE MAILED: 11/19/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/609,147

Applicant(s)

WALKER ET AL.

Examiner

Jeffrey D. Carlson

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NW

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 16 August 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 75-108 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 75-108 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. This action is responsive to the paper(s) filed 8/16/04.

#### ***Claim Objections***

Claims 107 and 108 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim.

Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. These claims depend from claim 75 which is a method claim. Dependant claim 107 and 108 switch statutory classes and result in improper dependant claims. These claims can be infringed by possession of a CD-Rom programmed to perform the steps of claim 75 (107) and said CD-Rom and a processor (108), yet possession of these items do not by themselves infringe claim 75. These claims therefore fail the infringement test in MPEP 608.01(n), Section III.

#### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-108 are rejected under 35 U.S.C. 101 because they do not provide a useful, concrete and tangible result. The claims determine a compensation and merely *request* that the slot machine provide the compensation. Without the slot machine actually providing the compensation, no useful, concrete and tangible result is set forth.

***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 75, 76, 79-97, 99-103, 105-108 are rejected under 35 U.S.C. 103(a) as being unpatentable over Raven et al (US5429361) in view of Plainfield et al (US5893075).

Regarding claim 75, 81, 106, 107, 108, Raven et al teaches programmed slot machines and networks which identify players and deliver promotional messages to the players [abstract]. Promotional messages may include notices of special events, special rates, etc. [5:58-61]. Frequent players can earn bonus or frequent player points by spending certain amounts [8:25-27]. At the slot machine, the player is identified via his playerID card and his history/accumulation of points is displayed [7:52-56]. Special players are identified and treated differently based on their card data and amount being played [9:60-68]. Although Raven et al teaches that messages may request that the player respond interactively to enter requested information [5:63-64], Raven et al does not teach compensating a selected the player for responding to a survey. Plainfield et al teaches surveying identified customers and rewarding the customers for responding as a means to create an incentive for participating in the marketing survey. It would have been obvious to one of ordinary skill at the time of the invention to have collected

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valuable marketing/profile/preference data from selected identified customers of Raven et al and to have rewarded them for participation. Plainfield et al teaches rewarding the customers with entry into contests (games of chance), etc and it would have been obvious to one of ordinary skill at the time of the invention to have rewarded the selected identified slot players with any incentive including points in the bonus points system disclosed by Raven et al. Regarding claim 106, the signal is clearly after the response is received and is taken to meet the broad "soon after" language.

Regarding claim 76, 102, 103, it would have been obvious to one of ordinary skill at the time of the invention to have selected any type of player, including losing players, for rewarding participation in a data gathering survey, so that the survey data could be collected for any type of targeted segment. The reward-based survey itself can be taken to be an offer.

Regarding claims 79-80, the reward can viewed by the player as "offsetting or "erasing" a loss.

Regarding claim 80, 83-97, Official Notice is taken that it is well known for casinos to "comp" players with free plays/tokens, credits, cash, reduced rates, free rooms and to manipulate the prize tables, activate additional paylines/reels in order to increase the players chance of winning and it would have been obvious to one of ordinary skill at the time of the invention to have provided such as the compensation for the survey taking of Plainfield et al.

Regarding claim 82, Official Notice is taken that video poker machines are well known to be used in casinos and it would have been obvious to one of ordinary skill at

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the time of the invention to have credited the players with free/bonus points or credits to be used at any machine including video poker (a game of skill).

Regarding claims 99-101, it would have been obvious to one of ordinary skill at the time of the invention to have provided the survey question(s) at any time during the gambling session. Further, applicant's claiming of various times to send the question is evidence of a lack of criticality regarding such timing.

Regarding claim 105, any response is taken to be a commitment for providing truthful answers.

4. Claims 76, 84, 102, 103 and alternatively, 77, 78, are rejected under 35 U.S.C. 103(a) as being unpatentable over Raven et al in view of Plainfield et al and Liverance (US5971850). Liverance teaches that the slot machine can adapt and make the chance for success easier if the player is losing in order to optimize the players interest in the game and sustain the time played at the machine [2:24-64]. It would have been obvious to one of ordinary skill at the time of the invention to have targeted losing players of Raven et al and offered them opportunities to complete surveys in order to increase their chances of future winning if they participate and continue playing. Regarding claim 77, Raven et al teaches that entire player histories (i.e. plural sessions) are tracked. Regarding claim 78, any amount losing can be said to be above a threshold of \$0.00. The reward-based survey itself can be taken to be an offer.

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5. Claim 98 is rejected under 35 U.S.C. 103(a) as being unpatentable over Raven et al in view of Plainfield et al and Paige (US5941772). Paige teaches putting ad logos on slot reels. It would have been obvious to one of ordinary skill at the time of the invention to have provided such ad-enhanced reels with the systems of Raven et al and Plainfield et al in order to exploit the player's gambling attention for advertising revenue. In the obvious case of providing free points/credits/plays, the compensation is taken to be allowing the player to watch and play the ad-enhanced reels.

6. Claim 104 is rejected under 35 U.S.C. 103(a) as being unpatentable over Raven et al in view of Plainfield et al and Dyer (US5090734). Dyer teaches presenting an advertisement to a user and collecting answers from the user regarding questions about the product/ad. It would have been obvious to one of ordinary skill at the time of the invention to have collected such marketing information with the system of Raven et al/Plainfield et al in order to gather advertising and product information from casino customers.

### ***Response to Arguments***

Applicant's arguments with respect to the newly submitted claims have been considered but are moot in view of the new ground(s) of rejection.

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**Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey D. Carlson whose telephone number is 703-308-3402. The examiner can normally be reached on Mon-Fri 8:30-6p, (off on alternate Fridays).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on 703-305-8469. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Jeffrey D. Carlson  
Primary Examiner  
Art Unit 3622

jdc